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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,717	07/17/2003	Paul D. Forsythe	FORS-0968	2941

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David E. Allred
Schmeiser, Olsen & Watts LLP
18 East University Drive, #101
Mesa, AZ 85201

EXAMINER

GRAHAM, MARK S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,717

Applicant(s)

FORSYTHE ET AL.

Examiner

Mark S. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-48 and 56-66 is/are allowed.
- 6) ☒ Claim(s) 1,9,11-37 and 49-53 is/are rejected.
- 7) ☒ Claim(s) 2-8,10,38,54 and 55 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/17/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claims 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the limits of claims 33 and 34 are because the particular limits of the standards are not known and standards constantly change.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 9, 11, 12, 25-28, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan.

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Note Ryan's center tube 6, transition piece 22, barrel 4, end cap 2, coupler 20, knob at end of member 28. An assembly screw 114 engages a bushing 116 in the end of the tube (element 116 not labeled).

Concerning claims 9, 11, 12, 26, and 27 the ring around the top of the tube at the top of the barrel is considered the "ballast".

With regard to claim 37, elements 20 and 22 are considered the two connectable parts.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan.

Concerning claims 13, 18, and 19, Ryan does not specify the inner and outer diameter of his bat. However, absent a showing of unexpected results such would obviously have been up to the ordinarily skilled artisan depending on the weight and strength characteristics desired in the bat.

Regarding claims 14-17, 20, 21, 23, and 24, the examiner takes official notice that the claimed materials are commonly known and used in the art. Further, they would obviously have been suitable for Ryan's purpose.

Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Owen. Ryan discloses the claimed device with the exception of the

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particularly claimed weights. However, as disclosed by Owen (bottom of Col. 1) it is known in the art to use a wide variety of weights in the bat as desired by the user and that such may be adjusted by ballast supported by the end cap. It would have been obvious to one of ordinary skill in the art to have used various weights for Ryan's bat as well to tailor it to a particular user or for a particular purpose.

Claims 35, 36, and 49-52 rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Muhlhausen. Ryan only discloses one barrel. However, as disclosed by Muhlhausen it is known in the art to use multiple barrels. It would have been obvious to one of ordinary skill in the art to have done the same with Ryan's bat if it was desired to replace the barrel for training purposes.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13-25, 28, 35, and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/434,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because removal of

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the additionally claimed elements with their corresponding loss of function would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 9, 11, 26, 28, 29-34, and 49-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/434,553 in view of Owens. The claims are met by the '553 claims with the exception of the ballast. However, as disclosed by Owens such is known in the art. It would have been obvious to one of ordinary skill in the art to have used such on the bat of the instant claims to weight it as desired.

This is a provisional obviousness-type double patenting rejection.

Claims 2-8, 10, 38-48, and 54, and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 56-66 are allowed.

Rewolinski, Baum, Chen, Peng, Mabry, Ciesar et al., Turos, and Liu have been cited for interest because they disclose similar bats.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 703-308-1355.

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MSG
3/19/04

A handwritten signature in black ink, appearing to read 'MSG', with a long, sweeping horizontal line extending from the end of the signature towards the right margin of the page.

Mark S. Graham
Primary Examiner
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